

Response Under 37 CFR §1.116  
Expedited Procedure - Group 1733

In re Application of:

Docket No. 03500.013584.1

MASAKI MIZUTANI, et al.

Application No.: 09/813,137

Examiner: John L. Goff II

Filed: March 21, 2001

Group Art Unit: 1733

For: METHOD OF PRODUCING SEMICONDUCTOR  
 THIN FILM AND METHOD OF PRODUCING  
 SOLAR CELL USING SAME

Date: October 31, 2003

Mail Stop AF  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an Amendment in the above-identified application.

☒ No additional fee is required.

The fee has been calculated as shown below

CLAIMS AS AMENDED						
	(2) CLAIMS REMAINING AFTER AMENDMENT		(4) HIGHEST NO. PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL CLAIMS	* 5	MINUS	** 20	=	x \$9 \$18	
INDEP. CLAIMS	* 4	MINUS	*** 4	=	x \$43 \$86	
Fee for Multiple Dependent claims \$145*/\$290						
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT—						.00


\* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

\*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

- ☐ Verified Statement claiming small entity status is enclosed, if not filed previously.
- ☐ A check in the amount of \$\_\_\_\_\_ is enclosed.
- ☐ Charge \$\_\_\_\_\_ to Deposit Account No. 06-1205. A duplicate copy of this sheet is enclosed.
- ☒ Any prior general authorization to charge an issue fee under 37 C.F.R. 1.18 to Deposit Account No. 06-1205 is hereby revoked. The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. 1.16 and 1.17 which may be required during the entire pendency of this application, or to credit any overpayment, to Deposit Account No. 06-1205. A duplicate copy of this paper is enclosed.
- ☐ A check in the amount of \$\_\_\_\_\_ to cover the fee for a \_\_\_\_\_ month extension is enclosed.
- ☐ A check in the amount of \$\_\_\_\_\_ to cover the Information Disclosure Statement fee is enclosed.
- ☒ Applicants' undersigned attorney may be reached in our Costa Mesa, California office by telephone at (714) 540-8700. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

  
\_\_\_\_\_  
Attorney for Applicant

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03500.013584.1 (09/813,137)

### INTERVIEW OUTLINE

#### A. Background

##### I. Parent Application (09/333,019)

- a. Restriction imposed between claims of Group I and claims of Group II (see Notice of Allowance dated December 18, 2000)
- b. Group I was drawn to a method of producing a semiconductor thin film (classified in class 438, subclass 71)
  - i. Claims 1-18 and 23-26
- c. Group II was drawn to a method of producing a solar cell (classified in class 136, subclass 243)
  - i. Claims 19-22 and 27-29
- d. The Examiner distinguished Group I and Group II as a combination and subcombination
- e. As set forth by the Examiner, on page 2, the basis for the Restriction Requirement was:
  1. The combination of Group II does not require the subcombination of Group I; and
  2. The subcombination of Group I has a separate utility
- f. Each independent claim (Claims 19, 21 & 27) of Group II required:

- a method for producing a solar cell that can use any thin film; and
- the step of forming an electrode on the back of the thin film

,which are features associated with a method for producing a solar cell. Meanwhile, no claim in Group I includes the above two features.

- f. Applicants elected Group I, without prejudice to filing a divisional application for the non-elected group, Group II
- g. Group I claims subsequently issued in U.S. Patent No. 6,258,666 and a divisional application was filed for the subject matter of non-elected Group II

## II. Divisional Application (09/813,137)

- a. Amendment dated February 5, 2003
  - i. Dependent Claims 20, 22 and 28 (which were claims in non-elected Group II) were cancelled
  - ii. Applicants amended independent Claims 19 and 30 to include a features recited in cancelled Claims 20, 22 and 28
    - Specifically, Claims 19 and 30 were amended to contain the feature of a rotating thin film support member having a curved surface and the feature of the peeling of a semiconductor thin film away from the substrate

## B. Advisory Action (06/13/03) Details

- I. Amended independent Claims 19 and 30 not consonant in scope to the original claims subject to restriction in the parent

- a. "...amended independent claims of Group II, the currently pending claims, now require the primary basis of patentability of Group I (i.e., the limitation of rotating a thin film support member to remove the semi-conductor film) and thereby are not consonant with the restriction requirement in the parent application"

- page 2 of Advisory Action

C. Applicants' Response

I. § 121 Protection From Double Patenting Rejection Applies In This Instance

- a. 35 U.S.C. § 121, third sentence, provides:

A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

- b. Moreover, MPEP § 804.01, in pertinent part states:

The prohibition against holdings of double patenting applies to requirements for restriction between the related subjects treated in MPEP 806.04 through 806.05(i). . . , so long as the claims in each case are filed as a result of such requirement. . . The following are situations where the prohibition of double patenting rejection under 35 U.S.C. 121 does not apply: . . . (B) The claims of the different applications or patents are not consonant with the restriction requirement made by the examiner, since the claims have been changed in material respects from the claims at the time the requirement was made. For

example, the divisional application filed includes additional claims not consonant in scope to the original claims subject to restriction in the parent. In order for consonance to exist, the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction must be maintained (citations omitted).

II. The Line Of Demarcation Between Group I and Group II Was Not Crossed In This Instance

- a. The basis of the Restriction Requirement sets the line of demarcation
  - i. As set forth by the Examiner in the Restriction Requirement:
    1. The combination of Group II does not require the subcombination of Group I.
      - "In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group II claims to a solar cell can use any semiconductor thin film."
    2. The subcombination of Group I has a separate utility
      - "The subcombination has separate utility such as the semiconductor thin films can be used in numerous other devices line [sic] TFTs, CMOS, Etc."
  - ii. The above forms the basis for the Examiner's Restriction Requirement and the line of demarcation.

- b. The differences between the claims of Group I and the claims of Group II at the time of restriction determine the line of demarcation
- i. A feature-by-feature comparison of the Group I claims and the Group II claims show that the two groups share most of the same features and similar language
  - ii. However, each independent claim (Claims 19, 21 & 27) of Group II requires:
    - a method for producing a solar cell that can use any thin film; and
    - the step of forming an electrode on the back of the thin filmwhile Group I does not include the above features
  - iii. These are the features that are directed to the formation of the solar cell of Group II rather than the formation of the semiconductor thin film of Group I
  - iv. Accordingly, the line of demarcation here is that the Group II Claims have to include the features of a method of producing a solar cell and the forming of an electrode on the thin film
- c. Amended Claims 19 and 30 do not cross the line of demarcation and are therefore, consonant with the Restriction Requirement
- i. Both Group I and Group II contain claims with similar limitations including the phrase "rotating a thin film support member having a curved surface"
    - Compare claims of Group I and Group II

- ii. Although in the divisional application, Claims 19 and 30 were amended to incorporate the above limitation, the method for producing solar cells of Group II and the method for developing thin films of Group I remain the same.
- iii. In this instance, Applicants only added more limitations to Claims 19 and 30 that were already found in Group I and in Group II.
- iv. The reason for requiring the restriction arguably was because the combination claims, which included the subject matter of Group I, also included the method of producing a solar cell and the forming of the electrode on the thin film.
- v. The amendments did not change or alter the distinguishing features of Group II, the method of producing a solar cell and the forming of the electrode on the thin film, thereby preserving the invention of Group II, which is a method for producing a solar cell as opposed to a method of producing a semiconductor thin film, as in Group I.
- vi. Accordingly, with the amendments to Claims 19 and 30, Applicants maintain that the Restriction Requirement is still preserved as the line of demarcation is still exactly the same as at the time of the restriction.

III. Advisory Action's Contention That The Currently Pending Claims, Now Require The Primary Basis Of Patentability Of Group I (i.e., the limitation of rotating a thin film support member to remove the semi-conductor film) Is Immaterial To The Issue Of Consonance

- a. Restriction Requirement did not indicate that the feature of "rotating a thin film support member having a curved surface" was the basis for the restriction requirement



- b. One cannot equate the reason(s) for an allowance with the reason(s) (or basis) for a restriction
  - i. In this instance, the Advisory Action is incorrectly trying to equate the two even though in most cases, and in this one, the reasons for allowance are different than the reasons for a restriction
- c. Therefore, the line of demarcation is not determined by this feature or limitation.
- d. Rather the line of demarcation was set according to the Examiner's finding that Group II and Group I differed in that Group II was drawn to a method for producing a solar cell and Group I was not.
- e. In addition, the fact that both Group I and Group II contained the same or similar language directed to the feature of "rotating a thin film support member having a curved surface" at the time of the Restriction Requirement contradicts the Advisory Action's assertion that the feature was the basis for the restriction.
- e. As explained above, the line of demarcation has not changed with the amendments of Claims 19 and 30

D. Conclusion

- I. Whether or not the currently pending claims, now require the primary basis of patentability of Group 1 (i.e., the limitation of rotating a thin film support member to remove the semi-conductor film)"is not material and not a legitimate basis for maintaining a double patenting rejection.
  - a. This feature was not an issue when the Restriction Requirement was made
  - b. This feature was claimed in both Group I and Group II when restriction was made.

II. The facts and policy behind Section 121 are relevant.

a. The facts are:

- The rotating thin film support member and peeling a thin film from the substrate features were present in both Group I and II when the Restriction Requirement was made.
- As explained above, the incorporation of features or matter already within Group II into Claims 19 and 30 does not change the line of demarcation in the Restriction Requirement. The line of demarcation differentiated Group I from Group II by the following features:
  1. A method for producing a solar cell;
  2. The step of forming an electrode on back of the thin film and
  3. Use of the thin film in different combinations than a solar cell.

b. As a matter of policy, Section 121 applies in situations like this one to protect amended claims in one group from being held invalid because of possible technical flaws and the vagaries of restriction practice.

i. Section 121 acts to protect the Examiner in addition to the Applicants from any later second-guessing or hindsight regarding the Restriction Requirement as a matter of public policy

III. The present claims are consonant with the claims of Group II since they contain the same features relied upon by the Examiner as the line of demarcation (i.e. 1. solar cell vs. film and 2. electrode) between Groups I and II.

- IV. In light of the foregoing, and no other matters being raised, Applicants believe the entire application is fully in condition for allowance, and such action is courteously solicited.

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 Commissioner for Parents  
 P.O. Box 1450  
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Date 11/03/2003  
 Atty. Docket 03500-013584.1  
 Application No. 09/813,137

Sir:

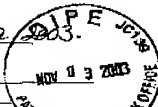
Kindly acknowledge receipt of the accompanying:

- ☒ Response to Official Action, dated April 22, 2003.
- ☐ Check for \$ \_\_\_\_\_ (claims fee)
- ☐ Petition under 37 CFR 1.136 and Check for \$ \_\_\_\_\_
- ☐ Notice of Appeal and Check for \$ \_\_\_\_\_
- ☐ Information Disclosure Statement, PTO-1449 and \_\_\_\_\_
- ☐ Claim for priority and certified copies of \_\_\_\_\_
- ☐ Issue fee transmittal and Check for \$ \_\_\_\_\_
- ☒ Other (specify) Transmittal and copy of Interview Outline.

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Atty. GKN/dlmDue Date 12/03/03

37 CFR 1.8 ☐  
 37 CFR 1.10 ☐  
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